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## REMARKS

### Claims 1-2, 7, 10-13, 16, and 18: Section 103(a) Rejection

Claims 1-2, 7, 10-13, 16, and 18 have been rejected under 35 USC 103(a) as being unpatentable over Carroll et al. (5,266,94) in view of Brennan (5,587,740) and Bursell (5,993,001). Claims 1, 11, and 18 are independent claims, from which the other claims ultimately depend. Claims 1, 11, and 18 have been amended to better clarify their claimed invention. First, the "best photo . . . of the person" aspect of the claims has been further clarified as being that "from which the person is most easily recognized," in addition to having already been "a best picture of the face of the person." Support for this amendment is found in the patent application as filed at least on page 5, lines 23-25.

Second, the preambles of claims 1, 11, and 18 have been amended to limit their application to a "surveillance system," in the case of claim 1, and a "surveillance method," in the case of claims 11 and 18. Support for this amendment is found in the patent application as filed at least on page 3, lines 7-8. Applicant notes that the preamble to a claim is to be accorded "the import that the claim as a whole suggests for it." (MPEP, sec. 2111.02) More specifically, "[i]f the claim preamble, when read in the context of the entire claim, . . . 'is necessary to give life meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." (*Id.*)

With respect to the preambles of claims 1, 11, and 18, the MPEP additionally cites *Kropa v. Robie*, 137 F.2d 150 (CCPA 1951), as providing an example that is particularly apt in the context of the preambles of claims 1, 11, and 18.

> A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims . . . . The court stated that "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an 'abrasive article.' . . ." Therefore, the preamble served to further define the structure of the article produced.

(MPEP, sec. 2111.02) Similarly, it is only by the phrase "a surveillance system" that it can be known that the subject matter defined by claim 1 is comprised as a "surveillance system," and that only be the phrase "a surveillance method" that it can be known that the subject

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matter defined by claims 11 and 18 are each comprised as "a surveillance method." Applicant therefore requests that the Examiner accord the weight of these amendments to the preambles of claims 1, 11, and 18 that they are due in further consideration of their patentability.

Applicant asserts that claims 1, 11, and 18 are not rendered obvious over the cited prior art, and presents three separate and independent bases for the patentability of claims 1, 11, and 18. First, Brennan and Bursell are not properly combined with Carroll, such that a *prima facie* case of obviousness has not been made. Second, Brennan and Bursell are non-analogous to the subject matter of the claimed invention, such that a *prima facie* case of obviousness has not been made. Third, Carroll, in view of Brennan and Bursell, do not teach the claimed invention, such that a *prime facie* case of obviousness has not been made. Claims 2, 7, 10, 12-13, and 16, as dependent claims, are patentable for at least these same reasons that independent claims 1, 11, and 18 are. Applicant now discusses in detail each of these separate and independent bases for patentability.

*Brennan and Bursell are not properly combined with Carroll*

The Examiner has cited Carroll as teaching a camera and a detection mechanism to cause the camera to take one or more photos of a person, in response to detection of an event; Brennan as teaching a digital camera and a face detection and selection mechanism to determine the best photo of the one or more photos; and Bursell as teaching a database to store the best photo of the person with at least a current date in which the best photo was taken. Applicant asserts that these combinations are improper.

Applicant first notes that the Federal Circuit has informed that

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

*In re Fritch*, 972 F.2d 1260 (Fed Cir. 1992). Furthermore, the Federal Circuit has also noted that examiners "cannot pick and choose among individual parts of assorted prior art

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references 'as a mosaic to recreate a facsimile of the claimed invention.'" *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471 (Fed. Cir. 1986).

The Examiner has participated in exactly this sort of impermissible behavior in combining Brennan and Bursell with Carroll. Carroll is a directed to an electronic monitoring system that teaches a camera and a detection mechanism. Because Carroll does not teach a face detection and selection mechanism and a database, the Examiner went looking for other prior art, using the invention of claims 1, 11, and 18 as an "instruction manual" or "template," and in so doing employing impermissible hindsight reconstruction. The Examiner found Brennan, which is directed to a digital photo kiosk that provides postcards at scenic attractions, as teaching a face detection and selection mechanism, and found Bursell, which is directed to a stereoscopic imaging system for retinal examination, as teaching a database.

It is dubious at best, however, that one of ordinary skill in the art would combine aspects of a digital photo kiosk that provides postcards at scenic attractions, to which Brennan is directed, with the electronic monitoring system of Carroll. It is also dubious at best that one of ordinary skill in the art would combine aspects of a stereoscopic imaging system for retinal examination, to which Bursell is directed, with the electronic monitoring system of Carroll. The Examiner cannot merely use the invention of claims 1, 11, and 18 as a "template" to pick and choose among individual parts of assorted prior art references, utilizing hindsight reconstruction to combine what are otherwise very separate references. Absent a clear motivation within the prior art to combine electronic monitoring systems with digital photo kiosks that provide postcards at scenic attractions and with stereoscopic imaging systems for retinal examinations, Brennan and Bursell cannot be combined with Carroll.

Furthermore, with specific respect to the Examiner's combining Brennan with Carroll so that the system of Carroll includes a face detection and selection mechanism, Applicant notes that section 2143.01 of the MPEP states that "the prior art must suggest the desirability of the claimed invention." More specifically,

> Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art.

(*Id.*) However, there is no explicit or implicit motivation to combine Brennan with Carroll to include a face detection and selection mechanism.

For instance, in the context of a surveillance system or method like that of the independent claims 1, 11, and 18, the application as filed notes that at least some embodiments of the invention provide for certain advantages when used in the context of the premises of a store, thus representing the desirability of the claimed invention.

> Rather than having to review several days worth of video tape from a video surveillance system, a user only has to scroll through the various faces stored in the database during a period of time, which is likely to be less time-consuming. ... [T]he user may be able to search for the photo of the face of a desired person based on what has been purchased by him or her.

(P. 2, ll. 21-25, through p. 3, ll. 1-4) Having a face detection and selection mechanism thus is desirable in the claimed invention because it is likely to decrease the length of time for the user to review the photos of the faces of a number of persons that may have visited the premises of his or her store, in order to locate the photo of the face of a particular person (*e.g.*, to assist the authorities with finding the suspect in an attempted robbery, in case the suspect had previously cased the store during a previous, seemingly innocuous visit, and so on).

There is no comparable desirability in combining Brennan with Carroll to yield a system having a face detection and selection mechanism. Carroll is directed to

> An electronic monitoring system that monitors an abuser for compliance with a protective order. When a violation is detected, the system automatically gathers evidence, independent of any that may be provided by the victim of the abuse, to establish probable cause of such violation.

(Abstract) The desirability of combining Brennan with Carroll to provide a face detection and selection mechanism is negligible at best. The electronic monitoring system of Carroll is meant to record a violation of an already known particular abuser of a protective order. There is no motivation to also include a face detection and selection mechanism by combining Brennan with Carroll so that, for instance, a particular face of a desired unknown person is easily found among the faces of a large number of unknown persons.

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For example, in the case of a battered wife having sought a protective order against her estranged husband, there is no need to have a face detection and selection mechanism to identify the estranged husband and select the best photo of his face so that he can be easily recognized. The estranged husband would already be known – by the battered wife at least, and certainly by the fact that he has a uniquely identifiable transmitter bracelet attached to his leg, as shown in FIG. 2 of Carroll. In such cases, there will typically be only two faces in all the pictures of the husband and the wife, and the pictures will only be taken while the husband is violating the protective order. There is no motivation to combine Brennan with Carroll to include a face detection and selection mechanism, because the authorities do not have to comb through days worth of pictures to find pictures of the husband.

Indeed, combining Brennan with Carroll frustrates the intended purpose of Carroll. The crux of Carroll is to automatically gather evidence, via the camera, when the abuser of the protective order has tripped the detection mechanism. It is at least seemingly reasonable that the goal would be to gather as much evidence as possible. Introducing a face detection and selection mechanism, as combining Brennan with Carroll does, would mean that the large amount of evidence gathered would be culled down to a single photo of the face of the abuser, from which the abuser is most easily recognized. However, the point of having the evidence is not to being able to easily identify the abuser per se, but rather to establish probable cause of the violation of a protective order.

Whittling down the pictures taken by the camera in Carroll to yield a single best photo of the face of the abuser would certainly not provide sufficient evidence of probable cause of the violation of the protective order by the abuser, although this is what combining Brennan with Carroll would require. Having only a single photo of the face of the abuser would more than likely provide *insufficient* evidence of probable cause, countering the entire point of having the electronic monitoring system of Carroll in the first place. Combining Brennan with Carroll thus destroys the intended functionality and purpose of Carroll.

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*Brennan and Bursell are non-analogous prior art*

The invention of claims 1, 11, and 18 as amended is directed to a "surveillance system" or a "surveillance method." As such, Brennan and Bursell are non-analogous prior art to the claimed invention. Brennan is directed to a digital photo kiosk that provides postcards at scenic attractions, whereas Bursell is directed to a stereoscopic imaging system for retinal examination. Both of these are highly non-analogous to a surveillance system or a surveillance method.

The Federal Circuit has noted that

> [a] reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem . . . . [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

*In re Clay*, 966 F.2d 656 (Fed. Cir. 1992) The Federal has also stated that

> We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances" – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

*In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992) Applicant asserts that one of ordinary skill within the art would not look to Brennan and Bursell in addressing the problem that the claimed invention solves, nor is it common sense to look to Brennan and Bursell in addressing the problem that the invention of claims 1, 11, and 18 solves.

The filed patent application describes the type of problems that are solved by the claimed invention

> [S]uch surveillance systems have some disadvantages. For example, if a theft has occurred, but the exact time of which is not known, several days worth of videotape may have to be reviewed to learn who has perpetrated the theft. This can be a very time-consuming and inconvenient process.

(P. 1, ll. 19-22) The invention of claims 1, 11, and 18 solve these and other problems, as also recited in the filed patent application.

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Rather than having to review several days worth of videotape from a video surveillance system, a user only has to scroll through the various faces stored in the database during a period of time, which is likely to be less time-consuming.

(P. 2, ll. 22-25)

By comparison, Brennan and Bursell are directed to subject matter that is wholly unrelated – and non-analogous – as compared to the surveillance systems and methods of the claimed invention. Brennan is directed to a digital photo kiosk providing postcards at scenic attractions. The recited field of the invention of Brennan is that it "relates generally to vending machines, and, in particular, to vending machines providing photographic postcards." (Col. 1, ll. 4-6) The background section in Brennan is further informative.

Recreational travelers often wish to have a photographic record not only of the places they visit but also of themselves at those places. Such photographs may be later shared with friends or kept to serve as a memory of the trip. For this reason, many travelers bring a camera along on their trip to take pictures of the various sights.

(Col. 1, ll. 10-15)

Brennan is thus non-analogous to the surveillance systems and methods of the amended claims 1, 11, and 18. The surveillance systems and methods of the claimed invention have nothing to do with photo kiosks that provide postcards. The surveillance systems and methods of the claimed invention having nothing to do with vending machines that provide postcards. The surveillance systems and methods of the claimed invention have nothing to do with the concerns of recreational travels and the photographs they take. In sum, Brennan is improperly relied upon as analogous prior art to the claimed invention.

Bursell is directed to a stereoscopic imaging system for retinal examination. The recited field of the invention of Bursell is that it "relates to systems and methods for examining and treating the eye, and more particularly, to . . . systems . . . that provide stereoscopic images of the retina of an eye." (Col. 1, ll. 10-15) The background section in Bursell is also informative.

Diabetes is the leading cause of blindness in working age adults. It is disease that, among its many symptoms, includes a progressive impairment of

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the peripheral vascular system. These changes in the vasculature of the retina
cause progressive vision impairment and eventually complete loss of sight.

. . . .

Accordingly, it would be desirable to implement more widespread
screening for retinal degeneration or pathology, and to positively address the
financial, social and cultural barriers to implementation of such screening. It
would also be desirable to improve the efficiency and quality of retinal
evaluation.

(Col. 1, ll. 15-22; col. 2, ll. 1-6)

Bursell is thus non-analogous to the surveillance systems and methods of the amended

claims 1, 11, and 18. The surveillance systems and methods of the claimed invention have

nothing to do with retinal examination. The surveillance systems and methods of the claimed

invention have nothing to do with diabetes, or the peripheral vascular system. The

surveillance systems and methods of the claimed invention have nothing to do with

implementing eye screening, nor with improving the quality of retinal evaluations. As such,

Bursell is also improperly relied upon as analogous prior art to the claimed invention.


*Carroll, in view of Brennan and Bursell, do not teach the claimed invention*

In rejecting claims 1, 11, and 18 under 35 USC 103(a) over Carroll in view of

Brennan and Bursell, the Examiner has relied upon Brennan as teaching a face detection and

selection mechanism that determines a best photo of one or more photos of a person,

including a best picture of the face of the person. Applicant has also amended claims 1, 11,

and 18, such that the best picture of the face of the person of the best photo is "from which

the person is most easily recognized." Applicant asserts that Brennan, and thus Carroll in

view of Brennan and Bursell, do not disclose such face detection and selection.

The Examiner states that Brennan specifically teaches

a comparison process/routine 118 executed by computer 32 to compare the
image 28(a) with a template image 114 to indicate if the scenic image 12 has
the people image superimposed on the scenic image 12 (figs. 4-5; col. 5, lines
23-29); and the image 28(a) is also compared to the template 114 to detect an
obstruction on the lens 13 or a blur on the image 28(a) (col. 6, lines 21-28);
which serves as a software of photo detection and selection mechanism to

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determine the best photo of one or more photos (figs. 4-5; col. 2, lines 17-45; col. 5, lines 9-38; col. 6, lines 12-28).

(Office Action, p. 3, first para.)  Pointedly, however, the Examiner does not show where Brennan discloses selecting the best photo of one or more photos, *including a best picture of the face of the person*.  However, the MPEP notes that

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).  "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382 (CCPA 1970).

(MPEP, sec. 2143.03)

The Examiner has not shown that Brennan teaches the selection of a best photo that *includes a best picture of the face of the person*, to which the claimed invention is limited, and *from which the person is most easily recognized*, as to which claims 1, 11, and 18 have been amended.  Brennan's best photo selection process only determines whether a photo has not been blurred and whether the people image has been superimposed on the scenic image. This is a far cry, however, from a best picture of the face of a person from which the person is most easily recognized.  Brennan's selection mechanism performs a different functionality than does that of the claimed invention.  Brennan does not teach the selection of a best picture in the way that amended claims 1, 11, and 18 are limited, taking into account that all words in a claim must be considered in judging its patentability against the prior art.  Carroll in view of Brennan and Bursell, therefore, do not render the claimed invention obvious.

### Claims 3 and 19: Section 103(a) Rejection

Claims 3 and 19 have been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Brennan and Bursell, and further in view of Lee (5,151,945).  Claims 3 and 19 are dependent claims depending ultimately from independent claims 1 and 18.  Therefore, claims 3 and 19 are patentable for at least the same reasons that claims 1 and 18 are patentable.

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Claims 4-5 and 14-15: Section 103(a) Rejection

     Claims 4-5 and 14-15 have been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Brennan and Bursell, and further in view of Clever (4,145,715). Claims 4-5 and 14-15 are dependent claims ultimately depending from independent claims 1 and 11. Therefore, claims 4-5 and 14-15 are patentable for at least the same reasons that claims 1 and 11 are patentable.

     Furthermore, Applicant asserts that claims 4-5 and 14-15 are specifically independently patentable, irrespective of the patentability of claims 1 and 11 from which they depend. Claim 4 recites the detection mechanism being a cash register, such that ringing up a sale to the person on the cash register causes the digital camera to take one or more photos of the person. Claim 14 recites detecting a sale to the person having been rung up on a cash register as the event in response to which one or more photos of the person are taken. Claim 5 depends from claim 4, and claim 15 depends from claim 14. Therefore, claims 5 and 15 are patentable for at least the same reasons that claims 4 and 14 are patentable.

     Applicant submits that Carroll in view of Brennan and Bursell, and further in view of Clever, do not disclose the invention of claims 4 and 14. The Examiner has stated that

>     Clever teaches a surveillance system having a camera used in conjunction with a cash register 14 at a point of sale transaction, where the functionality of the cash register is to ring up a sale to a person on the cash register for a transaction purpose.
>     It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to apply the detection mechanism of Carroll as modified by Brennan and Bursell to the point of sale transaction system as taught by Clever in order to obtain a clear image identification detection system in sale environment for the purpose of capturing the customer's identification and image record keeping . . . . Accordingly, it would have been an obvious modification as taught by Carroll as modified by Brennan and Bursell in applying a k known system to other operations.

(Office Action, p. 5, second and third paras.)

     Again, however, the Examiner has neglected to consider all the words in claims 4 and 14 in judging their patentability. Claims 4 and 14 are directed to the ringing up of a sale to a person on the cash register as causing the digital camera to take one or more photos of the

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person. The cash register is itself the detection mechanism. By comparison, Clever, while disclosing a cash register within a point of sale transaction environment, does not disclose the use of a sale itself on the cash register as causing pictures to be taken.

The Examiner has thus seemingly missed the point of claims 4 and 14 by failing consider all their words. It is beside the point whether the detection mechanism of Carroll, as modified by Brennan and Bursell, is applicable to the point of sale transaction system as taught by Clever. The point of difference is that the detection mechanism of Carroll, as modified by Brennan and Bursell, does not disclose using a cash register – and the ringing up of a sale thereon – as the detection mechanism to cause photos of a person to be taken, nor does Clever teach such usage of a cash register and the ringing up of a sale thereon. Clever, and Carroll in view of Brennan and Bursell and further in view of Clever, do not render the invention of claims 4 and 14 obvious.

## Claim 6: Section 103(a) Rejection

Claim 6 has been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Brennan and Bursell, and further in view of Monroe (6,366,311). Claim 6 is a dependent claim depending ultimately from independent claim 1. Therefore, claim 6 is patentable for at least the same reasons that claim 1 is patentable.

## Claims 8-9, 17, and 20: Section 103(a) Rejection

Claims 8-9, 17, and 20 have been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Brennan and Bursell, and further in view of Kuperstein (6,128,398). Claims 8-9, 17, and 20 are dependent claims ultimately depending from independent claims 1, 11, and 18. Therefore, claims 8-9, 17, and 20 are patentable for at least the same reasons that claims 1, 11, and 18 are patentable.

## Conclusion

Applicants hav mad a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved

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issues that require adverse action, it is respectfully requested that the Examiner telephone Jim

McDaniel, Applicants' Attorney, at 208-396-4095, or Mike Dryja, Applicants' Attorney, at

425-427-5094, so that such issues may be resolved as expeditiously as possible. For these

reasons, and in view of the above amendments, this application is now considered to be in

condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

4-30-03                          _____
Date                             Michael A. Dryja, Reg. No. 39,662
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Marked-up version of claims

     The following version of the claims shows the amendments made thereto. Additions are indicated by underlining.

1.     (once amended) A surveillance system comprising:

     a digital camera;

     a detection mechanism to cause the digital camera to take one or more photos of a person, in response to detection of an event;

     a face detection and selection mechanism to determine a best photo of the one or more photos of the person, the best photo including a best picture of the face of the person from which the person is most easily recognized; and,

     a database to store the best photo of the face of the person with at least a current date in which the best photo was taken, the database also storing a plurality of best photos of faces of people.

11.     (once amended) A surveillance method comprising:

     taking one or more photos of a person;

     determining a best photo of the one or more photos of the person, the best photo including a best picture of a face of the person from which the person is most easily recognized; and,

     storing the best photo of the face of the person with at least a current date in which the best photo was taken in a database also storing a plurality of best photos of faces of people.

18.     (once amended) A computer-readable medium having instructions stored thereon to perform a surveillance method comprising:

     detecting a event;

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in response to detecting the event, causing a digital camera to take one or more photos

of a person;

determining a best photo of the one or more photos of the person, the best photo

including a best picture of a face of the person from which the person is most easily

recognized; and,

causing the best photo of the face of the person to be stored with at least a current date

in which the best photo was taken in a database also storing a plurality of best photos of faces

of people.